UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,976	01/21/2000	William J. Baer	STL000014US1	5177

23373 7590 06/07/2004		EXAMINER	
SUGHRUE MION, PLLC		PHAM, HUNG Q	
2100 PENNSYLVANIA AVENUE, N.W.			
SUITE 800		ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037		2172	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/488,976</td><td>Applicant(s)
BAER ET AL.</td></tr>
<tr><td>Examiner
HUNG Q PHAM</td><td>Art Unit
2172</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 October 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *19, 20 & 21*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 10/15/2003, 01/29/2004 and 04/03/2004 was filed before the mailing date of a Final Office action. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   **Claims 2, 5, 9, 13, 18, 21 and 25-30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 2, 5, 9, 13, 18 and 21 recite the limitation *the content entity* in the step of receiving a user-provided location. There is insufficient antecedent basis for this limitation in the claim.

Claims 25-30 recite the limitation *the plurality of content entities*. There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
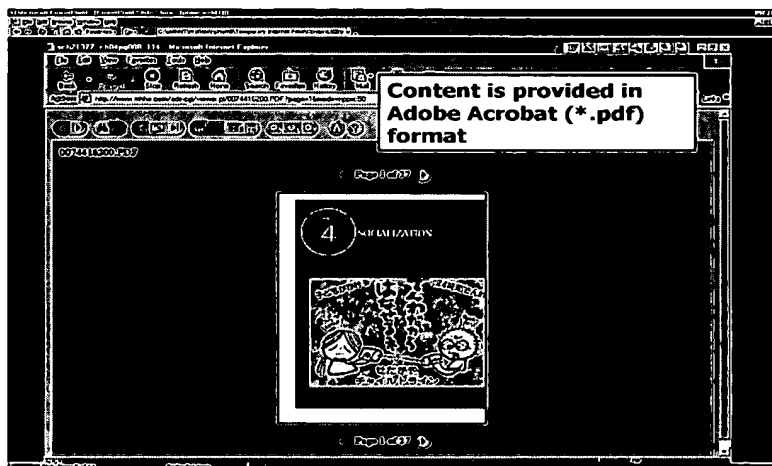
This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.   **Claims 1, 4, 6-7, 9, 12, 14-15, 17, 20, 22-23 and 25-30 are rejected**

under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies
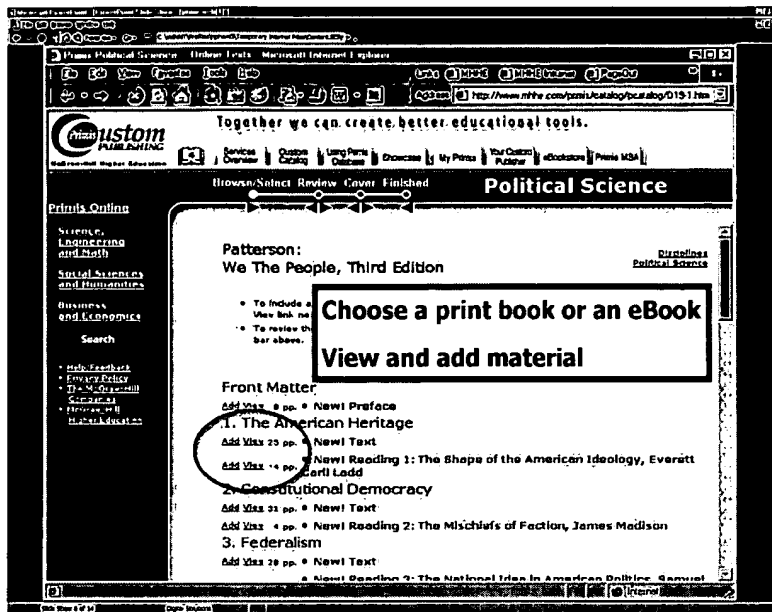
(McGraw-Hill) [Build a Book Online,

http://web.archive.org/web/19980513002459/http://mhhe.com/primis/ and

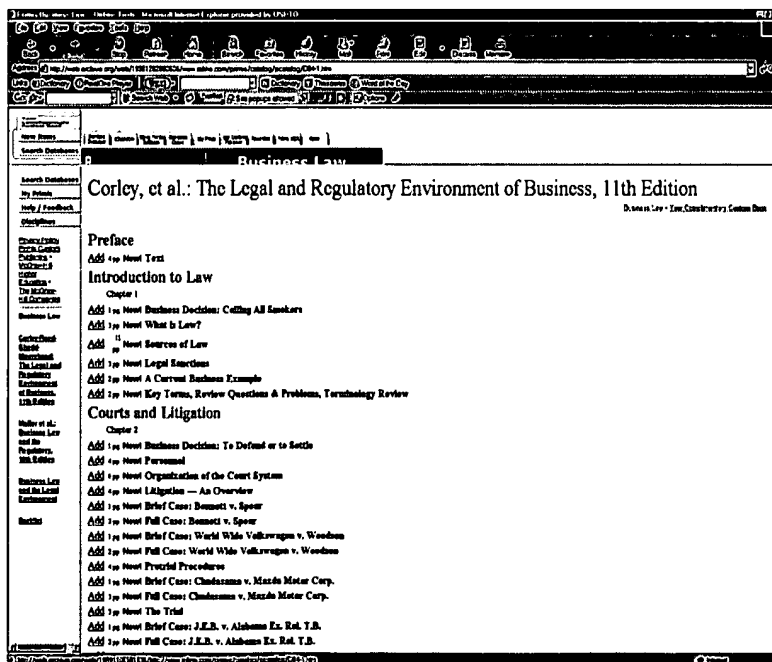**http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt]**.

Regarding to claims 1, 9 and 17, McGraw-Hill teaches a method and system for

building an e-book as *a content object stored as a plurality of content entities*. As shown on

the Presentation Presenting How To Use Primis Online, the e-book as *content object is*

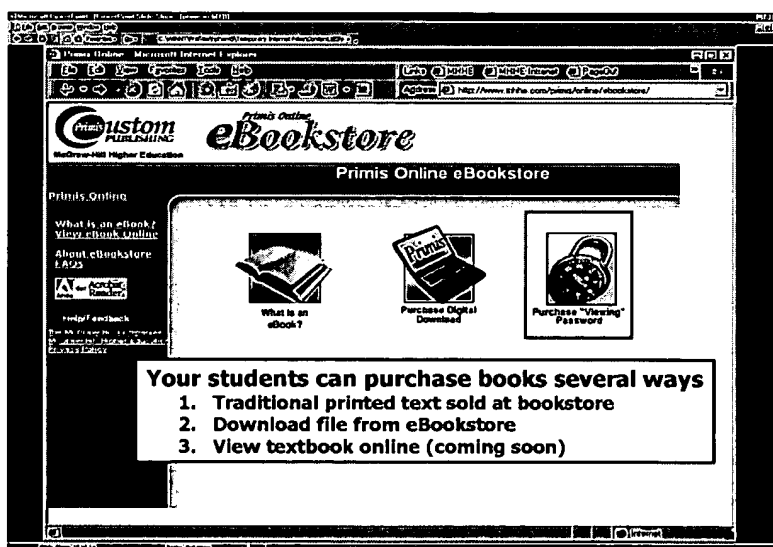*defined* by a list of chapters and sections as *content entity identifiers*.

The e-book is built by *receiving* the content of the corresponding chapters and

sections as *user-provided content* when the user clicks the add button as shown on

McGraw-Hill Primis Custom Publishing with the *assigned* chapter name or section name
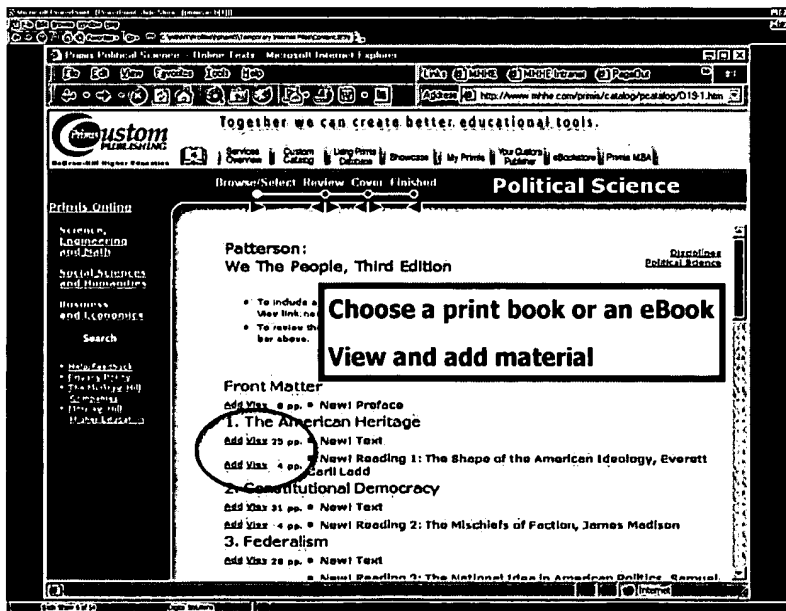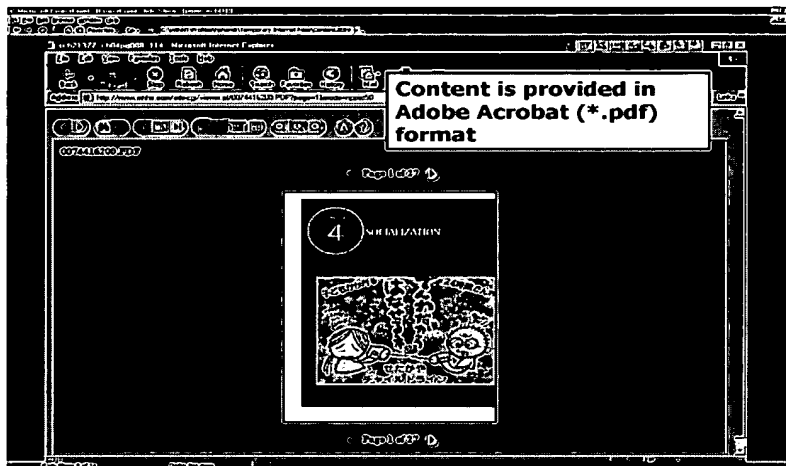
as *identifier*.

After selecting a chapter or section by the adding button, the selected chapter or section as *identifier of the user-provided content is added to the list* of chapters and sections as in the Presentation Presenting How To Use Primis Online, whereby *the user-provided content is added to the* e-book as *the content object*. McGraw-Hill does not explicitly teach *the user-provided content and its identifier are stored in the data repository*. However, as in the Presentation Presenting How To Use Primis Online, a user could download the e-book as one way to purchase the book. In order to download the e-book, obviously, the e-book that contains *the user-provided content and its identifier* has to be stored in *a data repository* at the server site.

Primis Online eBookstore

Your students can purchase books several ways
1. **Traditional printed text sold at bookstore**
2. **Download file from eBookstore**
3. **View textbook online (coming soon)**

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by storing the e-book in a data repository in order to build and download a customized e-book.
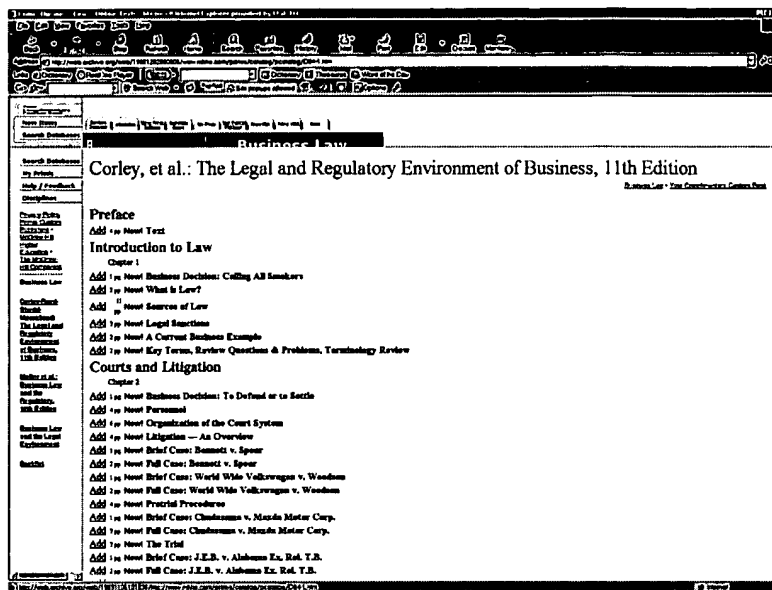
Regarding to claims 4, 12 and 20, McGraw-Hill teaches a method and system for

building an e-book as *a content object stored as a plurality of content entities*. As shown on

the Presentation Presenting How To Use Primis Online, the e-book as *content object is*

defined by a list of chapters and sections as *a hierarchical outline of containers and*

content entity identifiers.

The e-book is built by *receiving* the content of the corresponding chapters and

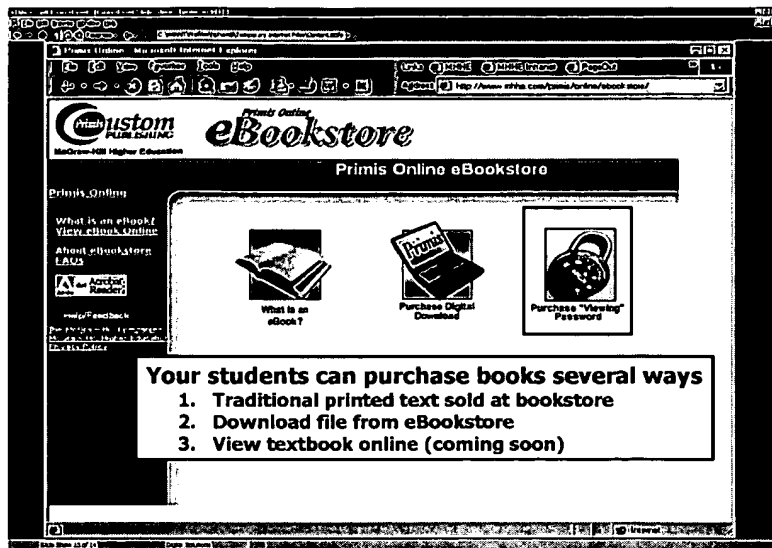sections as *user-provided content* when the user clicks the add button as shown on

McGraw-Hill Primis Custom Publishing with the *assigned* chapter name or section name
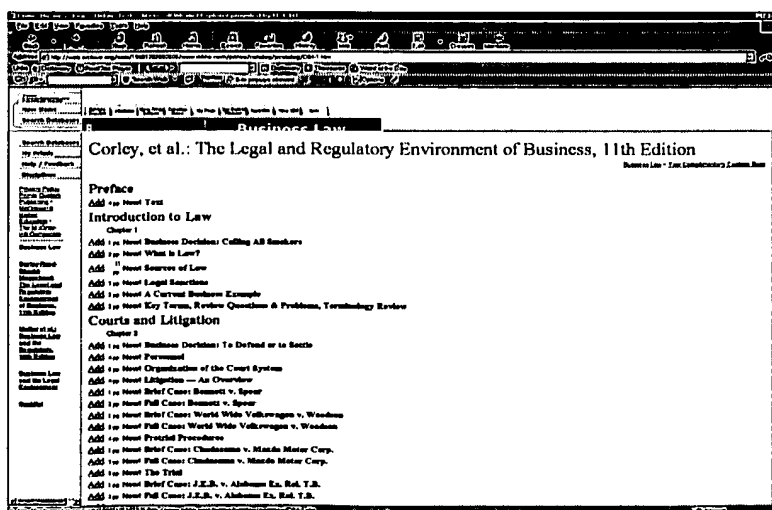
as *identifier*.

After selecting a chapter or section by the adding button, the selected chapter or

section as *identifier of the user-provided content is added to the outline* of chapters and

sections as in the Presentation Presenting How To Use Primis Online, thereby *the user-

provided content is added to the* e-book as *the content object*. McGraw-Hill does not

explicitly teach *the user-provided content and its identifier are stored in the data repository*.

However, as in the Presentation Presenting How To Use Primis Online, a user could

download the e-book as one way to purchase the book. In order to download the e-

book, obviously, the e-book that contains *the user-provided content and its identifier* has to

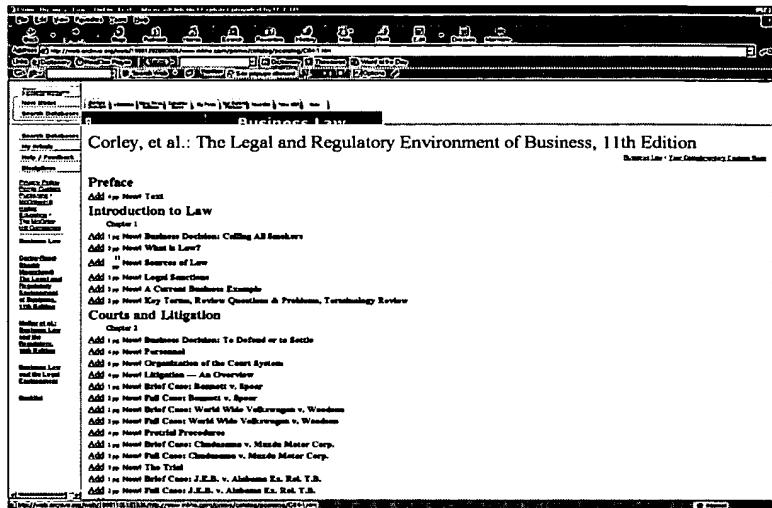be stored in *a data repository* at the server site.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by storing the e-book in a data repository in order to build and download a customized e-book.

Regarding to claims 6, 14 and 22, McGraw-Hill teaches all the claimed subject matters as discussed in claims 4, 12 and 20, McGraw-Hill further discloses *the user-provided content comprises a content entity* (McGraw-Hill Primis Custom Publishing).
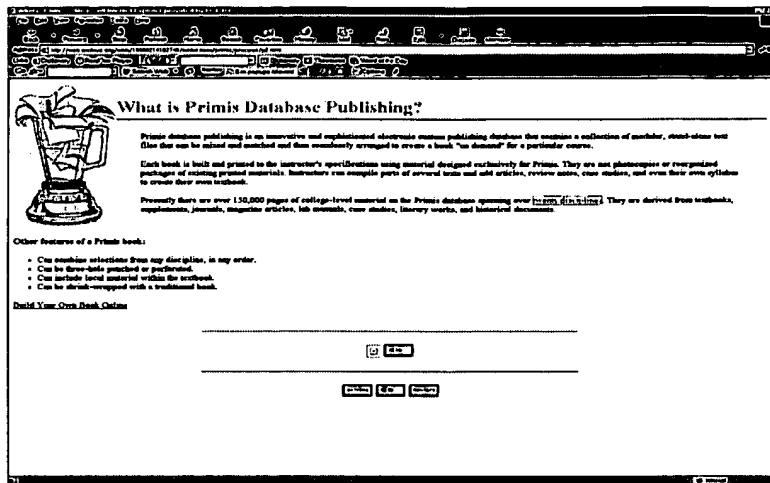
Regarding to claims 7, 15 and 23, McGraw-Hill teaches all the claimed subject matters as discussed in claims 4, 12 and 20, McGraw-Hill further discloses the user-provided content comprises a container (McGraw-Hill Primis Custom Publishing).

Regarding to claims 25-30, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 24, 9, 12, 17 and 20 McGraw-Hill further discloses *the received user-provided content is not of the content object and wherein the plurality of content entities define the content object as a compilation of related content* (McGraw-Hill Primis Custom Publishing).

7.   **Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 are rejected under 35**

U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw-

Hill) [Build a Book Online,

http://web.archive.org/web/19980513002459/http://mhhe.com/primis/ and

http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt] in view of Rowe

[USP 6,073,148].

Regarding to claims 2, 5, 10, 13, 18 and 21, McGraw-Hill teaches all the claimed

subject matters as discussed in claims 1, 4, 9, 12, 17 and 20, but does not explicitly

discloses the step of *receiving a user-provided location for inserting the content entity into*

the content object, and inserting the identifier into the list at that location. Rowe teaches a

method for creating an optimized PDF file, by creating a list of objects and shared

objects to organize the objects and place the objects in the optimized file in the same

order (Rowe, Col. 10, Line58-Col. 11, Line 13). It would have been obvious for one of

ordinary skill in the art at the time the invention was made to modify the McGraw-Hill

method by including the technique of organizing the object in the list in order to build a

customized e-book.

Regarding to claims 3, 8, 11, 16, 19 and 24, McGraw-Hill and Rowe teaches all

the claimed subject matters as discussed in claims 2, 5, 10, 13, 18 and 21, Rowe further

discloses the step of *providing a user interface communicating with the data repository, and*

providing mechanisms for receiving the user-provided content and specification of a desired

location through the user interface (Rowe, Col. 10, Line58-Col. 11, Line 13).

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 703-605-4242. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
May 18, 2004

SHAHID ALAM
PRIMARY EXAMINER